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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/514,410	11/15/2004	Thomas Heidenfelder	53543	4386
26474	7590 10/20/2005		EXAM	INER
NOVAK DRUCE DELUCA & QUIGG, LLP 1300 EYE STREET NW SUITE 400 EAST			PUTTLITZ, KARL J	
			ART UNIT	PAPER NUMBER
WASHINGTO	WASHINGTON, DC 20005			<del>-</del>
			DATE MAILED: 10/20/2005	5

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	10/514,410	HEIDENFELDER ET AL.
Office Action Summary	Examiner	Art Unit
	Karl J. Puttlitz	1621
The MAILING DATE of this communicate Period for Reply	tion appears on the cover sheet wi	th the correspondence address
A SHORTENED STATUTORY PERIOD FOR WHICHEVER IS LONGER, FROM THE MAIL  - Extensions of time may be available under the provisions of 3' after SIX (6) MONTHS from the mailing date of this communic  - If NO period for reply is specified above, the maximum statuto  - Failure to reply within the set or extended period for reply will, Any reply received by the Office later than three months after the earned patent term adjustment. See 37 CFR 1.704(b).	LING DATE OF THIS COMMUNION (7 CFR 1.136(a). In no event, however, may a ration.  ry period will apply and will expire SIX (6) MON by statute, cause the application to become AB	CATION.  eply be timely filed  ITHS from the mailing date of this communication.  EANDONED (35 U.S.C. § 133).
Status		
1) Responsive to communication(s) filed of 2a) This action is <b>FINAL</b> .  2b) Since this application is in condition for closed in accordance with the practice of the second seco	☑ This action is non-final. allowance except for formal matt	•
Disposition of Claims		
4) ⊠ Claim(s) 12-21 is/are pending in the ap 4a) Of the above claim(s) is/are v 5) □ Claim(s) is/are allowed. 6) ⊠ Claim(s) 12-21 is/are rejected. 7) □ Claim(s) is/are objected to. 8) □ Claim(s) are subject to restriction	vithdrawn from consideration.	
Application Papers		
9) The specification is objected to by the E 10) The drawing(s) filed on is/are: a) Applicant may not request that any objection Replacement drawing sheet(s) including the 11) The oath or declaration is objected to by	accepted or b) objected to n to the drawing(s) be held in abeyar correction is required if the drawing	nce. See 37 CFR 1.85(a). (s) is objected to. See 37 CFR 1.121(d).
Priority under 35 U.S.C. § 119	,	
12) ⊠ Acknowledgment is made of a claim for a) □ All b) □ Some * c) ⊠ None of:  1. □ Certified copies of the priority doc 2. □ Certified copies of the priority doc 3. ☒ Copies of the certified copies of the application from the International * See the attached detailed Office action for	cuments have been received. cuments have been received in A he priority documents have been Bureau (PCT Rule 17.2(a)).	pplication No received in this National Stage
Attachment(s)  1)	4) 🗍 Interview S	Summary (PTO-413)
<ul> <li>Notice of References Cited (PTO-092)</li> <li>Notice of Draftsperson's Patent Drawing Review (PTO-3)</li> <li>Information Disclosure Statement(s) (PTO-1449 or PTO Paper No(s)/Mail Date 11/15/2004.</li> </ul>	948) Paper No(s	s)/Mail Date nformal Patent Application (PTO-152)

#### **DETAILED ACTION**

### Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states that R<sup>3</sup> are those specific alkyl and cycloalkyl groups listed in the claims. However, stage II states that any cyclic C3-C12-alcohol or cyclic C3-C10 alcohol may be added as the esterified group R<sup>3</sup>. This protion of the rejection would be withdrawn if stage III was amended to include those specific groups metioned earlier in the claim.

In stage III, the term "which comprises crystallizing the ester" is unclear because the step refers to esterification, not crystallization. This portion of the rejection qwould be withdraw if the claim was amended to recite "further comprising crystallizing . . . ".

Claim 20 depends on claim 8, which has been canceled.

## Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent No. 6,409,995 to Habeck et al. (Habeck) in view of JP 06100512, attaches as Chemical Abstracts online citation, Abstract No. 1994:435021, [retrieved on 10/14/2005], Columbus, OH, USA (JP 512).

The rejected claims are drawn to, inter alia, a process for preparing compounds of the following formula I:

by the following reaction:

This step is followed by esterification to provide compounds of formula I.

The claims specifically require crystallizing the ester of formula I and purifying the crystals in a further process stage by treatment with an adsorbent and/or by distillation.

Habeck teaches the following reaction at column 10:

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With regard to the specific n-hexyl esters of formula (Ia) (see, for example, claims16, 21 and dependant claims), habeck contemplates these dericatives at column 2:

(see definitions for "X").

Habeck fails to teach the step of crystallizing the ester of formula I and purifying the crystals in a further process stage by treatment with an adsorbent and/or by distillation. It is for this proposition that the examiner joins JP 512.

Specifically, JP 512 teaches, with regarding the following compounds:

that aminohydroxybenzophenonecarboxylic acid derivatives of formula I are prepared by reaction of m-aminophenol derivatives of formula II with phtthalic anhydride.

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The abstract teaches that the products are readily separated from the reaction mixture by crystallization. While the combination of references fails to explicitly teach treatment with an adsorbent and/or by distillation, those of ordinary skill would understand that this step, without any objective evidence of unexpected benefit, would further purify the desired product. Therefore, treatment with an adsorbent and/or distillation is well within the motivation of those of ordinary skill, and thus, the combination of Habeck and JP 512 renders the rejected claims *prima facie* obvious, since these references teach the elements of the rejected claims with a reasonable expectation of success.

#### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at telephone number (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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